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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,139	02/02/2004	John P. Downs	5398-CIP-CON-3	9662

22922 7590 03/30/2007  
REINHART BOERNER VAN DEUREN S.C.  
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1000 NORTH WATER STREET  
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MILWAUKEE, WI 53202

EXAMINER
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AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/30/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/770,139	<b>Applicant(s)</b> DOWNS, JOHN P.	
	<b>Examiner</b> Nasser Ahmad	<b>Art Unit</b> 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,7,9-14,16 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7,9-14,16 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/8/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/9/2007 has been entered.

### ***Rejections Withdrawn***

2. Claims 1, 3-4, 6-7, 9-11, 14-16 and 18-22 rejected under 35 USC 102(b) as being anticipated by Torrey made in the Office Action of May 23, 2005 has been withdrawn in view of the amendment filed on 12/22/2006.

3. Claims 1, 3-7, 9-16 and 18-22 rejected under 35 USC 103(a) as being unpatentable over Torrey has been withdrawn in view of the amendment.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1, 3, 5, 7, 9-14, 16 and 20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, 5, 7, 9-14, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Torrey (3741786).

Torrey relates to an adhesive dispensing tape (10) comprising a flexible carrier tape (12) having a transverse width, a row of adhesive segments (14) spaced apart along the longitudinal length of the tape and transversely in side-by-side relation, each segments being disposed between the two side edges, and can be transferred by flexing the tape.

The adhesive is pressure sensitive adhesive (PSA) (col. 3, line 30) and applied to the carrier in a hot melt form, hence it includes hot melt adhesive. The carrier tape is provided with first and second release surfaces such that the adhesive segments adhere less strongly to the second release surface when unwound from a roll (col. 2, lines 8-12 and col. 3, lines 5-12). The adhesive segments are centered along the transverse width of the tape to form a longitudinally straight line as shown in figure-1.

The segments can be of any shape such as dots, bars, star, triangle, etc. or any pattern without any criticality (col. 3, lines 57-68). The dot shape would exhibit circular configuration. The transverse position of each segment is distinct as shown by their separate position along the tape length. In col. 6, lines 32-37, Torrey teaches that any portion of the adhesive can be transferred from the carrier tape to a substrate, thereby indicating that each adhesive segments is individually exposable to an abutting planar

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surface when the carrier tape is transversely flexed. Further, figure-1 shows that the each of the tape edge is at least equal to the adhesive segments. However, Torrey fails to teach that the adhesive segments are aligned in sided-by-side relation. It would have been obvious to one having ordinary skill in the art to modify torrey by providing the adhesive segments as aligned in side-by-side relation at transversely separated locations, since such a modification would have involved a mere change in the pattern or design of the adhesive segments in the longitudinal segments of the carrier tape, as such a change in pattern provides for aesthetic appeal.

For claim 5, Torrey clearly discusses that the shape of the adhesive segments are not critical and it can have any desired shape. Thus, it would have been obvious to one having ordinary skill in the art to modify Torrey by providing its adhesive segments in a disc shape, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 149 USPQ47 (CCPA 1976).

### ***Response to Arguments***

7. Applicant's arguments filed 12/22/2006 have been fully considered but they are not persuasive.

Applicant's argument of the 35 USC 102(b) rejection over Torrey is moot in view of the withdrawal of said rejection.

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Responding to applicant's arguments that Torrey fails to disclose that a plurality of adhesive segments are disposed non-contiguously spaced apart are aligned in column extending along the length, applicant is directed to figure-1 which clearly shows said feature.

As for the argument that the adhesive segments are also aligned in side-by-side relation transversely, applicant is directed to figure-1 which shows side-by-side relation transversely positioned adhesive segments. For the segments to be aligned, it has been explained hereinbefore, that such a change is deemed to be an obvious design choice modification in pattern, which is directed to aesthetic appeal.

Regarding the spacing along the tape edge providing a margin, applicant should note that figure-1 shows the margin which is at least equal to the adhesive segment.

For applicant's argument that Torrey's adhesive segments are not dispensed individually, applicant is directed to col. 6, lines 32-37, wherein Torrey teaches that any portion of the adhesive can be transferred from the carrier tape to a substrate, thereby indicating that each adhesive segment is individually exposable to an abutting planar surface when the carrier tape is transversely flexed. Further, Torrey states that the pattern of the adhesive segments are not critical, any pattern would have been obvious matter of design choice.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the claimed invention is anticipated or rendered obvious over the prior art of record discussed above.

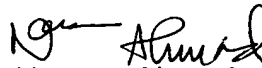
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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772  
3/27/07

N. Ahmad.  
March 27, 2007.